

REMARKS

In the Official Action dated April 25, 2004, Claims 1, 3, and 5-12 have been rejected under 35 U.S.C. §112 as allegedly indefinite. Claims 1, 3, and 5-12 have been rejected under 35 U.S.C. §112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention.

This response addresses each of the Examiner's objections and rejections. Accordingly, the present application is in condition for allowance. Favorable consideration of all pending claims is therefore respectfully requested.

Claims 1, 5, 6, 9, and 10 have been amended in this response for the purpose of expediting prosecution. No new matter has been added, no narrowing amendments have been made, and no amendments have been made in view of prior art. Entry of this amendment is respectfully requested.

The Examiner has rejected Claims 1, 3, and 5-12 under 35 U.S.C. §112 as allegedly indefinite. The Examiner has made the following rejections in this regard:

A. The Examiner rejected composition Claims 5 and 7 as allegedly substantial duplicates. For purposes of expediting prosecution, Applicants have cancelled claim 7 and have added the non-overlapping subject matter of Claim 7 into Claim 5. The cancellation of Claim 7 renders this rejection moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

B. The Examiner rejected composition Claims 6 and 8 as allegedly substantial duplicates. For purposes of expediting prosecution, Applicants have cancelled Claim 8 and have added the non-overlapping subject matter of Claim 8 into Claim 6. The cancellation of Claim 8 renders this rejection moot. Accordingly, Applicants respectfully

request reconsideration and withdrawal of this rejection.

C. The Examiner rejected composition Claims 9 and 11 as allegedly substantial duplicates. For purposes of expediting prosecution, Applicants have cancelled Claim 11 and have added the non-overlapping subject matter of Claim 11 into Claim 9. The cancellation of Claim 11 renders this rejection moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

The Examiner rejected composition Claims 10 and 12 as allegedly substantial duplicates. For purposes of expediting prosecution, Applicants have cancelled Claim 12 and have added the non-overlapping subject matter of Claim 12 into Claim 10. The cancellation of Claim 12 renders this rejection moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

The Examiner has rejected Claims 1-3 and 5-12 under 35 U.S.C. §112, first paragraph, as allegedly lacking an enabling disclosure. The Examiner requested test data for the compounds.

In response, Applicants respectfully submit that Claims 1-3 and 5-12 were enabled at the time the present application was filed. Claim 4, which has been allowed in the instant case, lists a number of different compounds which exemplifies a broad range of compounds that fall within the generic scope of Claim 1. In addition, there is no requirement, and it is not necessary to submit test data to satisfy 35 U.S.C. §112, first paragraph.

Furthermore, Applicants respectfully submit that sufficient direction and guidance to practice the claimed invention is disclosed throughout the specification as follows:

Page 7, paragraphs 94-97 and page 8, paragraphs 98-122, disclose, as an example, how to measure the affinities of the claimed compounds for serotonin 7 receptors.

Page 8, paragraph 123, discloses how measure the 5HT7 IC₅₀ values for the claimed compounds.

Page 8, paragraphs 124-136 and page 9, lines 139-140, disclose how to evaluate the claimed compounds as 5HT7 receptors.

Page 8, paragraph 142, discloses how to determine the activity of the active compounds as antidepressants and related pharmacological properties.

Applicants respectfully submit that based on the above disclosures in the present application, no undue experimentation is required to determine the utility and activity of the claimed compounds as antidepressants and related pharmacological properties. A considerable amount of experimentation is permissible, if it is merely routine, or if the specification provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. The present application provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. Accordingly, the present application provides sufficient direction and guidance to the skilled artisan to practice the invention as claimed. In re Wands, 858 F.2d 731, 736-737, 8 U.S.P.Q. 1400, 1404 (Fed Cir. 1988). Necessary experimentation is not determinative of the question of enablement; only undue experimentation is fatal under the provisions of 35 U.S.C. §112, first paragraph. Id.

The Examiner also alleges that compounds having the ability to antagonize 5HT7 receptor sites are not necessarily enabling for the treatment of diseases listed in the claims. Applicants respectfully submit that the clinical significance of compounds that have the ability to antagonize 5HT7 receptor sites is known in the art and

is enabling for the treatment of diseases listed in the claims. See 5HT7: Pharmaceutical opportunities in the fields of CNS and cardiovascular diseases, which was submitted in Applicants previous response. The 5HT7 article states that "5-HT7 receptors are implicated in the pathogenesis and prophylactic treatment of migraine as well as depression, schizophrenia and cardiovascular disease." Accordingly, this article provides credible evidence that the compounds of the present invention, which bind to 5-HT7 receptors, can be useful for treating the specific diseases listed in the claims. The specification, as filed, discloses to one skilled in the art how to make and use the invention without undue experimentation.

Therefore, it is respectfully submitted that the rejection under 35 U.S.C. §112, first paragraph, is overcome. Withdrawal of the rejection is respectfully requested.

Thus, in view of the foregoing amendments and remarks, the application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



Peter I. Bernstein
Registration No. 43,497

Scully, Scott, Murphy & Presser
400 Garden City Plaza-Suite 300
Garden City, New York 11530
516-742-4343

PIB/RLB:ej